

Appln No. 10/528,983
Amdt date April 11, 2007
Reply to Office action of December 12, 2006

REMARKS/ARGUMENTS

Reconsideration of the application is respectfully requested. Currently, claims 1, 2, 4-20, 22-24 and 26-45 are pending in the application. Claims 1, 2, 4, 6, 8, 10, 19 and 20 have been amended. Claims 3, 21 and 25 have been cancelled. Claims 26-45 have been added.

Improper Punctuation

The Examiner has objected to claim 10 because of an extra period following the number "10". Applicant has removed the extra period following the number "10", and respectfully submits that the Examiner's objection has been overcome.

35 U.S.C. §102(b): Robbins

The Examiner has rejected claims 1, 5, 6, 19, 20, 22, 23, and 25 as being anticipated by Robbins (US 5,107,637).

The standard for an anticipation rejection under 35 U.S.C. §102 has been well established by the Court of Appeals for the Federal Circuit, and is set forth in M.P.E.P. § 2131, which provides that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. In addition, the identical invention must be shown in as complete detail as is contained in the claim. For a prior art reference to anticipate a claimed invention, every element of the claimed invention must be identically shown in a single reference, and these elements must be arranged as in the claim under review.

Claim 1

Amended claim 1 recites:

1. A bus stop illuminating device comprising:
 - a power storage device;
 - a solar panel to charge the power storage device;
 - a first light source in electrical communication with the power storage device to provide illumination to the bus stop;
 - a first switch to control illumination of the first light source;
 - a second light source in electrical communication with the power storage device to signal a bus to stop; and
 - a second switch to control illumination of the second light source.

Applicant respectfully submits that amended claim 1 overcomes the Examiner's rejection because, for example, Robbins fails to disclose a second light source to signal a bus to stop. Accordingly, Applicant respectfully submits that the rejection of claim 1 under 35 U.S.C. §102(b) should be withdrawn.

Moreover, Applicant respectfully submits that claim 1 should be allowed despite the Examiner's rejection of now-canceled claim 3, which included limitations similar to those that have been added to claim 1 by the present amendments. In rejecting claim 3, the Examiner alleged that it would have been obvious to one of ordinary skill in the art to combine Robbins with Wescott (US 6,621,177) to arrive at the claimed invention (Office Action, paras. 19-20). Applicant respectfully disagrees.

The requirements for a prima facie case of obviousness have been well established by the Court of Appeals for the Federal Circuit, and are concisely summarized in MPEP §§ 2142 and 2143, which confirm that three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in

the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In light of these legal principles, Applicant respectfully submits that claim 1 as amended is not obvious under Robbins in view of Wescott because there is no suggestion or motivation to combine into one device a first light source to provide illumination to the bus stop with a second light source to signal a bus to stop, as recited in claim 1.

Applicant respectfully directs the Examiner's attention to MPEP § 2143.01 which states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990) ... Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.' 916 F.2d at 682, 16 USPQ2d at 1432. See also In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992) ...

In this regard, Applicant respectfully notes that the Court of Appeals for the Federal Circuit has stressed the importance of avoiding "the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." In re Dembicziak, 175 F.3d 994 at 999 (Fed. Cir. 1999). In that decision, the Court held that "the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *Id.* Therefore, the suggestion or motivation "must be clear and particular" in order to render a claimed invention obvious. *Id.*

In rejecting claim 3, the Examiner has referred to Figure 1 and a number of passages (col. 1, lines 18-26; col. 2, lines 1-10; col. 5, lines 12-17 and 35-46) from Wescott. Applicant respectfully submits that none of these, in any way, discloses or suggests a first light source to

provide illumination to the bus stop and a second light source to signal a bus to stop combined into one device, as recited in claim 1.

More generally, Applicant respectfully submits that Wescott fails to offer any suggestion or motivation at all to include a separate light source to provide illumination to the bus stop, and that Robbins fails to offer any suggestion or motivation at all to include a separate light source to signal a bus to stop. Accordingly, applying the Federal Circuit's "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references", Applicant respectfully submits that there is no "clear and particular" suggestion or motivation in the prior art to make the combination of claim 1.

In summary, Applicant respectfully submits that the rejection of claim 1 under 35 U.S.C. §102(b) should be withdrawn. Moreover, Applicant respectfully submits that claim 1 should be allowed despite the Examiner's rejection of now-canceled claim 3.

Claims 5 and 6

Claims 5 and 6 depend directly or indirectly on claim 1. Therefore, Applicant respectfully submits that claims 5 and 6 are allowable due to their dependencies on claim 1, and due to the additional subject matter that these claims recite. Accordingly, Applicant respectfully submits that the rejection of claims 5 and 6 under 35 U.S.C. §102(b) should be withdrawn.

Claim 19

Amended claim 19 recites:

19. A bus stop illuminating device comprising:
 - a support structure;
 - a lighting assembly mounted to the support structure and housing
 - a power storage device;

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- a solar panel to charge the power storage device;
- a first light source in electrical communication with the power storage device to provide illumination to the bus stop;
- a first switch mounted to the support structure to control illumination of the first light source;
- a second light source in electrical communication with the power storage device to signal a bus to stop; and
- a second switch mounted to the support structure to control illumination of the second light source.

Applicant respectfully submits that amended claim 19 includes limitations that are similar to limitations of amended claim 1. Therefore, for reasons similar to those given above in respect of claim 1, Applicant respectfully submits that claim 19 should be allowed, and the rejection of claim 19 under 35 U.S.C. §102(b) should be withdrawn.

Claims 20, 22, and 23

Claims 20, 22, and 23 depend directly or indirectly on claim 19. Therefore, Applicant respectfully submits that claims 20, 22, and 23 are allowable due to their dependencies on claim 19, and due to the additional subject matter that these claims recite. Accordingly, Applicant respectfully submits that the rejection of claims 20, 22, and 23 under 35 U.S.C. §102(b) should be withdrawn.

Claim 25

Claim 25 has been canceled.

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35 U.S.C. §103(a): Robbins in view of Wescott

The Examiner has rejected claims 2-4, 9, 12, and 14 as being unpatentable under Robbins in view of Wescott.

Claims 2 and 4

Claims 2 and 4 depend directly or indirectly on claim 1. Therefore, Applicant respectfully submits that claims 2 and 4 are allowable due to their dependencies on claim 1, and due to the additional subject matter that these claims recite. Accordingly, Applicant respectfully submits that the rejection of claims 2 and 4 under 35 U.S.C. §103(a) should be withdrawn.

Claim 3

Claim 3 has been canceled.

Claim 9

Claim 9 recites:

9. A lighting device for use at a bus stop comprising:
 - a solar panel;
 - a power storage device chargeable by the solar panel;
 - a first light source for illuminating an area adjacent the bus stop;
 - a second light source to signal a bus to stop;
 - a bus schedule assembly for displaying bus schedule information;
 - a third light source to illuminate the bus schedule assembly; and

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a switch assembly electrically connected between the power storage device and the light sources to allow operation of at least one of the light sources on actuation of the switch assembly.

Applicant respectfully submits that claim 9 includes limitations that are similar to limitations of amended claim 1. Therefore, for reasons similar to those given above in respect of claim 1, Applicant respectfully submits that claim 9 should be allowed, and the rejection of claim 9 under 35 U.S.C. §103(a) should be withdrawn.

Claims 12 and 14

Claims 12 and 14 depend directly or indirectly on claim 9. Therefore, Applicant respectfully submits that claims 12 and 14 are allowable due to their dependencies on claim 9, and due to the additional subject matter that these claims recite. Accordingly, Applicant respectfully submits that the rejection of claims 12 and 14 under 35 U.S.C. §103(a) should be withdrawn.

35 U.S.C. §103(a): Robbins in view of Guest

The Examiner has rejected claims 7, 8, and 24 as being unpatentable under Robbins in view of Guest (US 2004/0004827).

Claims 7 and 8

Claims 7 and 8 depend directly or indirectly on claim 1. Therefore, Applicant respectfully submits that claims 7 and 8 are allowable due to their dependencies on claim 1, and due to the additional subject matter that these claims recite. Accordingly, Applicant respectfully submits that the rejection of claims 7 and 8 under 35 U.S.C. §103(a) should be withdrawn.

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Claim 24

Claim 24 depends indirectly on claim 19. Therefore, Applicant respectfully submits that claim 24 is allowable due to its dependency on claim 19, and due to the additional subject matter that this claim recites. Accordingly, Applicant respectfully submits that the rejection of claim 24 under 35 U.S.C. §103(a) should be withdrawn.

35 U.S.C. §103(a): Robbins in view of Wescott and Doan

The Examiner has rejected claims 10 and 11 as being unpatentable under Robbins in view of Wescott and in further view of Doan (US 4,200,904).

Claims 10 and 11 depend directly or indirectly on claim 9. Therefore, Applicant respectfully submits that claims 10 and 11 are allowable due to their dependencies on claim 9, and due to the additional subject matter that these claims recite. Accordingly, Applicant respectfully submits that the rejection of claims 10 and 11 under 35 U.S.C. §103(a) should be withdrawn.

35 U.S.C. §103(a): Robbins in view of Wescott and Guest

The Examiner has rejected claims 13 and 15-18 as being unpatentable under Robbins in view of Wescott and in further view of Guest.

Claims 13 and 15-18 depend directly or indirectly on claim 9. Therefore, Applicant respectfully submits that claims 13 and 15-18 are allowable due to their dependencies on claim 9, and due to the additional subject matter that these claims recite. Accordingly, Applicant respectfully submits that the rejection of claims 13 and 15-18 under 35 U.S.C. §103(a) should be withdrawn.

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Claim 21

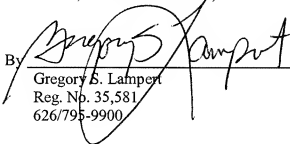
Applicant notes that according to the Office Action Summary, claim 21 was rejected, but Applicant was not able to locate the Examiner's basis for rejecting claim 21. In any event, claim 21 has been canceled.

New Claims

Applicant has added new claims 26 to 45. Applicant respectfully submits that these new claims define additional aspects of the invention, and patentably distinguish over the prior art.

Applicant respectfully requests further favorable consideration of the application.

Respectfully submitted,
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